



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/823,411 03/25/97 CHUNG

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IMS1/0309

EXAMINER

MICHELLE

ART UNIT

PAPER NUMBER

1714

DATE MAILED:

03/09/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on _____.

☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-113 is/are pending in the application.

Of the above claim(s) 31-59 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-30, 60-113 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit 1714

Claims 1-30 and 60-113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kafka. The Examiner's position remains as stated in the August 28 Office action. Applicants' arguments have been considered but are not persuasive. Applicants argue that the claims distinguish over Kafka because Kafka teaches the use of acid or salt solution or other coagulant. This argument is not persuasive because the claims do not exclude the use of such a coagulant. In claim 1 "comprising" is used three times. It is well established that the use of "comprising" in a claim provides for the possible inclusion of other unspecified method steps and provides for the inclusion of other unspecified ingredients. Therefore, a method according to claim 1 in which a coagulant is used to coagulate the latex is within the scope of claim 1. Applicants argue that Kafka does not suggest coagulating latex "by the very act of feeding a particulate filler". This argument is not persuasive because there is no corresponding limitation in the claims. The claims state that the latex is coagulated in the presence of filler, but there is no limitation concerning "by the very act". Applicants' argument concerning "mixing zone" and "coagulum zone" is not persuasive. There are no structural limitations on the reactor to distinguish a "mixing zone" from a "coagulum zone". A reactor in which a first portion is directed to mixing and a second portion is directed to coagulating is within the scope of the

Art Unit 1714

claims. Such a reactor would inherently be present in Kafka. Applicants' argument concerning the composition claims is also not persuasive. Claim 60 is directed to a composition comprising elastomer and filler. Compositions comprising elastomer and filler are old in the art. Accordingly, applicants' composition claims are not patentable. Applicants argue that Kafka does not teach "completely coagulate the elastomer latex with the particulate filler". This argument is not persuasive because it is directed to process limitations of claims 1-30 and is not directed to the composition of elastomer and filler. Any prior art composition comprising elastomer and filler which is in the solid state can properly be described as being completely coagulated. The argument concerning macrodispersion is not persuasive because there is no limitation in the composition claims concerning macrodispersion. Claim 60 is directed to a composition of elastomer and filler. Applicants have not established that any of the process limitations in claim 60 are material. Kafka establishes a prima facie case of obviousness for a composition of elastomer and filler. A prima facie case of obviousness may be overcome by a persuasive showing in affidavit or declaration form showing that the product of the claims is distinguishable from the product of the reference. Applicants have not submitted any such evidence in affidavit or declaration form.

Art Unit 1714

Claims 60-112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue or Asai or Simonet. The Examiner's position remains as stated in the August 28 Office action. Applicants' arguments have been considered but are not persuasive. Applicants make reference to a Bohm reference. This argument is not persuasive because Bohm is not a ground of rejection. Inoue, Asai, and Simonet all disclose compositions of elastomer and filler with macrodispersion. There is a presumption that the composition of elastomer and filler is within the scope of applicants' claims. There is a presumption that the compositions of elastomer and filler produced by these references meet the numerical limitations recited in claims 69-112. This is a prima facie case of obviousness. A prima facie case of obviousness may be obviated by a persuasive showing in affidavit or declaration form showing either that the claimed composition possesses unexpectedly superior properties over the composition of the prior art or showing that it is impossible to obtain the claimed composition by the methods shown in the prior art references. Applicants have not submitted any such affidavit or declaration.

THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first

Art Unit 1714

response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication should be directed to Paul Michl at telephone number (703) 308-2451.

The Examiner's supervisor is Vasu Jagannathan phone number (703) 306-2777. The fax number for this group is (703) 305-3599.

PRMichl:cdc

(703) 308-0661

March 8, 1999


PAUL R. MICHL
PATENT EXAMINER
ART UNIT 156